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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/759,181	01/20/2004	Bryan Paul Morgan	3007-1016-1	1314

466 7590 01/09/2008  
YOUNG & THOMPSON  
745 SOUTH 23RD STREET  
2ND FLOOR  
ARLINGTON, VA 22202

EXAMINER
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KEMMERER, ELIZABETH

ART UNIT	PAPER NUMBER
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1646

MAIL DATE	DELIVERY MODE
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01/09/2008

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

# Office Action Summary

Application No.

10/759,181

Applicant(s)

MORGAN ET AL.

Examiner

Elizabeth C. Kemmerer, Ph.D.

Art Unit

1646

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 18 October 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-13 is/are pending in the application.
- 4a) Of the above claim(s) 4-6 and 9 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 8 and 10-13 is/are rejected.
- 7) ☒ Claim(s) 1-3 and 7 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### ***Status of Application, Amendments, And/Or Claims***

The amendment of 18 October 2007 has been entered in full. Claims 4-6 and 9 remain withdrawn from consideration as being directed to a non-elected invention.

Claims 1-3, 7, 8, and 10-13 are under examination.

### ***Withdrawn Objections And/Or Rejections***

The rejection of claims 1-3, 7, 8, and 10 under 35 U.S.C. § 112, second paragraph, as set forth at p. 4 of the previous Office Action (mailed 18 April 2007) is *withdrawn* in view of the amended claims (amendment of 18 October 2007).

The rejection of claims 1-3, 7, and 8 under 35 U.S.C. § 112, first paragraph, regarding scope of enablement, as set forth at pp. 5-7 of the previous Office Action (mailed 18 April 2007) is *withdrawn* in view of the amended claims (amendment of 18 October 2007).

The rejection of claims 1-3, 7, and 8 under 35 U.S.C. § 112, first paragraph, regarding inadequate written description, as set forth at pp. 7-9 of the previous Office Action (mailed 18 April 2007) is *withdrawn* in view of the amended claims (amendment of 18 October 2007).

The rejection of claims 1-3, 7, and 8 under 35 U.S.C. § 102(b) as being anticipated by Rushmere et al. as set forth at p. 9 of the previous Office Action (mailed 18 April 2007) is *withdrawn* in view of the amended claims (amendment of 18 October 2007).

***Title***

The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed.

Applicant argues (p. 5, amendment of 18 October 2007) that a new title has been provided, thus overcoming the objection. This has been fully considered but is not found to be persuasive. The new title is "Porcine CD59 protein, nucleic acids and cells containing the same." Since proteins are not encompassed by the examined claims, the title is still inaccurate. Removing the word "protein" from the title would obviate the objection.

***35 U.S.C. § 112, Second Paragraph***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 8 and 11-13 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The claims are directed to cells containing specific nucleic acids. However, it is not clear if the claim is directed to isolated or cultured cells, or if Applicant intended the claims to encompass cells in the context of a transgenic organism. Amending the claims to recite that the cells are "isolated" or "cultured" would obviate the instant rejection.

**35 U.S.C. § 102**

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claim 10 is rejected under 35 U.S.C. 102(b) as being anticipated by WO 97/20937 (published 12 June 1997).

WO 97/20937 discloses isolated nucleic acid primers identical to Qo (SEQ ID NO: 6) and Q1 (SEQ ID NO: 7). See pp. 35 and 36.

***Claim Objections***

Claim 1 is objected to because of the following informalities: claim 1 contains a few minor typographical errors. As it has been amended, claim 1 now reads:

1. (Currently amended) An isolated DNA molecule **c.** coding for a polypeptide having the sequence of Figure 2 (SEQ ID NO. 1) or its complementary strand **d. e.** The letters and periods in bold type should be deleted. Also, a space should be inserted between "1)" and "or". Appropriate correction is required.

Claims 2, 3, and 7 are objected to as being dependent upon a base claim to which an objection has been made, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

***Allowable Subject Matter***

Claims 1-3, and 7 contain allowable subject matter if the typographical errors of claim 1 are corrected. The following is offered for Applicant's consideration as an additional allowable claim:

14. (New) A method of recombinantly expressing the polypeptide of SEQ ID NO: 1 comprising transfecting or transforming a cultured host cell with a vector comprising a nucleic acid sequence encoding a polypeptide having the sequence of Figure 2 (SEQ ID NO: 1), and culturing the cell under conditions so as to express the polypeptide having the sequence of Figure 2 (SEQ ID NO: 1).

It is noted that support for this claim flows naturally from the disclosure at least at pp. 37-41 of the specification. Additional claims directed to such subject matter will also be considered (e.g., dependent claims specifying that the host cells are U937 cells or PLECT cells).

***Conclusion***

No claims are allowed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Elizabeth C. Kemmerer, Ph.D. whose telephone number

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is (571) 272-0874. The examiner can normally be reached on Monday through Thursday, 7:00 a.m. to 5:30 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gary Nickol, Ph.D. can be reached on (571) 272-0835. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

ECK

/Elizabeth C. Kemmerer/  
Primary Examiner, Art Unit 1646